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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UDO KLEIN, UWE KLINGER, and MARTIN SCHOLZ

Appeal 2009-005208
Application 10/675,208
Technology Center 2100

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-20, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

The invention on appeal is directed to variable size user input areas in computer user interfaces. (Spec. 1).

Illustrative Claim 1

A method of displaying a user input area, the method comprising:

displaying a user input area within a computer user interface, wherein the user input area corresponds to a data field having a specified number of characters and has a size that visually indicates to a user that the user input area will accommodate therein visual representations of the specified number of characters of the data field;

upon receipt of a user input specifying a character to be included in the data field, displaying within the user input area a visual representation of the input character in a *proportional font*;

adjusting the size of the user input area based on a size of characters included in the data field and the specified number of characters of the data field, wherein the size of characters included in the data field includes a size of the input character; and

displaying the adjusted user input area having a new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the specified number of characters of the data field.

(Emphasis added regarding disputed limitations).

Rejection

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Inaki (US Pat. 5,230,062), Glaser (US Pat. 5,450,538) and Wallack (US Pat. 6,055,550).

Claim Grouping

Appellants argue claims 1-20 as a group. (Supp. App. Br. 3-7). We select representative claim 1 to decide the appeal for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Principles of Law

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Combinability of the references

ISSUE (1)

Under §103, did the Examiner err in combining the Inaki, Glaser, and Wallack references?

ANALYSIS

We begin our analysis by considering the threshold issue of whether the Examiner erred in combining the cited references. We observe that Appellants focus on the secondary Glaser and Wallack references in contending the references have been improperly combined. (Supp. App. Br. 5-7). Appellants summarize their combinability argument in the Reply Brief:

Applicants submit that the alleged motivation to combine the references is merely hindsight from reviewing the present claims. First, implementing Wallack's automatic resizing into Glaser would completely eradicate the user's freedom to adjust the field size. Second, modifying Glaser by Wallack's automatic resizing would defeat a feature explicitly touted in Inaki, namely that the user can define the size of the input field using the cursor.

(Reply Br. 2; *see also* Supp. App. Br. 5-7).

We disagree. Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966), we are also mindful that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

Here, we observe that the references relied on by the Examiner are directed to familiar elements (e.g., well known user interface elements such

as resizable user data entry areas and associated data fields, and input characters having associated fonts) that we find would have been readily combinable by an artisan according to known methods.

As pointed out by the Examiner (Ans. 13), we observe that Glaser teaches dynamically resizing a data entry field 141 (Figs. 2 and 4) by using a mouse that is placed over a “grabpoint” icon 147. (Col. 5, ll. 1-30). Although Wallack teaches an auto size function, we observe that Wallack contemplates embodiments where “the auto sizing function may be [manually] selected through use of a button displayed anywhere on the output display” and “[a] cursor control device, such as a mouse, may also be used to invoke the auto sizing function . . . [or] “through any well known means . . .” (Col. 5, ll. 52-62). As pointed out by Appellants, Inaki also teaches that “the user can define the size of the input field using the cursor.” (Supp. App. Br. 6, ¶4). Given this evidence, we see no reason why the respective manual and the automatic resizing features could not have been used by an artisan in a complementary fashion.

To the extent that Appellants may be advancing a “teaching away” argument (because Inaki and Glaser teach some form of manual resizing versus the automatic resizing of Wallack), our reviewing court guides that “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives *because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...*” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (emphasis added.)

This reasoning is applicable here. We further observe that Appellants have not rebutted the Examiner’s legal conclusion of obviousness by

showing that the claimed combination of familiar elements produces any new function. Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need.

Therefore, we find Appellants' arguments unavailing regarding the combinability of the Inaki, Glaser, and Wallack references for essentially the same reasons proffered by the Examiner in the Answer (pp. 5, 13-14), and as further discussed above. Accordingly, on this record, Appellants arguments have not persuaded us that the Examiner erred by improperly combining the cited references under § 103.

Representative Claim 1 (argued limitations)

ISSUE (2)

Under §103, did the Examiner err in finding that the combination of Inaki, Glaser, and Wallack would have taught or suggested:

[L1] *a proportional font*; [and]

[L2] *displaying the adjusted user input area having a new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the specified number of characters of the data field,*

within the meaning of representative claim 1?

Limitation L1 (a proportional font)

Regarding the claimed proportional font limitation (L1), Appellants present the following arguments:

Applicants note that Inaki does not appear to use proportional fonts. Rather, it appears Inaki contemplates characters of standardized widths that can be scaled to either full-size (where the example field holds 22 characters) or half-size (where the field holds 44 characters).

The Examiner cited to Inaki 17:53 et seq. (describing FIG. 24G) as allegedly teaching use of a proportional font. Applicants respectfully disagree. Inaki's FIGS. 24A et seq. show another example where the user is defining the sizes of input fields with the cursor. Thus, when Inalu states "the state of field definition is displayed" as cited by the Examiner, this apparently means that the system has filled in dummy characters up to the maximum field size (see FIG. 24G).
(Supp. App. Br. 4; *see also* Reply Br. 2).

Although the portion of Inaki pointed to by the Examiner (col. 17, l. 53; Ans. 3, last line) does not expressly teach the use of a proportional font, we find Inaki's express reference to "character size" (col. 17, 54) is at least suggestive of such fonts. "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Moreover, "[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed. . . ." *In re Bode*, 550 F.2d 656, 660 (CCPA 1977) (quoting *In re Wiggins*, 488 F.2d 538, 543 (CCPA 1973)) (underline added).

Those persons “must be presumed to know something” about the art “apart from what the references disclose.” *In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962).

Here, we find the use of proportional fonts (vs. non proportional fonts) would have been well within the knowledge of persons skilled in the art at the time of the invention and at least obvious to try. Our reviewing courts guide that a combination may be obvious when there was a “finite number of identified” solutions for solving a problem. *See Bayer Schering Pharma AG v. Barr Laboratories, Inc.*, 575 F.3d 1341, 1347 (Fed. Cir. 2009) (discussing KSR, 550 U.S. at 421). This reasoning is applicable here.

For these reasons, we are not persuaded by Appellants’ arguments that representative claim 1 is patentable over the cited combination of references because the scope of the claim encompasses the use of a proportional font.

Limitation L2

[L2] *displaying the adjusted user input area having a new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the specified number of characters of the data field.*
(Claim 1).

Regarding the *displaying the adjusted user input area* limitation (L2), Appellants present the following contentions:

The Examiner acknowledged that Inaki does not teach “visual indication of the change in size” or “adjusting the size of the user input area . . . ” . . . [I]t appears that the Examiner’s claim interpretation may not give appropriate (or perhaps any) weight to the requirement in the claims that the new size of the user input area visually indicates that the area will accommodate the “remaining number of the specified number

of characters". Nevertheless, Applicants agree that Inaki fails to disclose an input field that is adjusted to a new size after user input, wherein the new size visually indicates that the area will accommodate the remaining number of characters.

The Examiner then cited to Glaser and Wallack to provide the subject matter missing from Inaki.
(Supp. App. Br. 4-5).

Appellants address the teachings of Glaser, as follows:

Glaser's data entry field can apparently be resized independently of the maximum number of characters of the data field, and independently of any entry made in the field. Therefore, Glaser also does not perform the visual indication required by the present claims.
(Supp. App. Br. 5).

Appellants then address the teachings of Wallack:

Wallack, finally, discloses automatic sizing of fields for displaying computer forms. Wallack appears to teach that based on the size of a sample record a system can decide the column width to use for displaying a number of records. (Wallack 3:11-4:47.) In short, after a user selects a column to resize, the system retrieves a sample record and reads the size of the entry for the selected column. (Wallack 4:48-50.) The system then resizes the column to fit the largest amount of data found in the sample record(s). Accordingly, the size of the column cell is chosen so that an entry that has already been made will fit without obstruction. Wallack acknowledges that when the column size is set based on a sample, any record that contains more data in the field than the sample may require scrolling. (Wallack 4:61-63.) . . . There is [] no disclosure of taking into account a maximum number of characters that the field will accept into the resizing. As such, the fields taught by Wallack fail to visually indicate that the resized field will accommodate a remaining number of characters.
(Supp. App. Br. 5-6).

In the “Response to Arguments,” the Examiner disagrees:

The combination of the Glaser and Wallack teaches this limitation because Glaser teaches a user input field that is adjustable (see Galser; col. 5, lines 1-30) and Wallack teaches a data [field] that is adjustable based on the size of characters and the specified number of characters. (see Wallack; col. 5, lines 40-65; figure 2, steps 200 and 230; the auto size option) Therefore[,] the combination of Glaser and Wallack teaches a user input adjusted to a new size based on a size of characters included in the data field and the specified number of character the data [field].

(Ans. 13).

Appellants essentially restate their argument in the Reply Brief:

Not only does Inaki fail to disclose the visual indication required by the present claims, but Glaser and Wallack also does not disclose or suggest this subject matter. Glaser's data entry field can apparently be resized independently of the maximum number of characters of the data field, and independently of any entry made in the field. Wallack teaches that when the column size is set based on a sample, any record that contains more data in the field than the sample may require scrolling. As such, the visual indication of the present claims is simply not taught.

(Reply Br. 2).

Based upon our review of the record, we find the weight of the evidence supports the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness. We note that the Examiner’s rejection is based on the *combined* teachings and suggestions of the references.

As pointed out by the Examiner in the rejection of claim 1 (Ans. 5), Glaser teaches:

Advantageously, the system permits the customization of data input and output by enabling the user to exercise complete control over the size of the data field.
(Col. 2, ll. 22-25).

As also pointed out by the Examiner in the rejection of claim 1:

Wallack teaches adjusting the size of the user input area based on the size of characters included in the data field and the specified number of characters of the data field (i.e. steps 200 and 230 in FIG. 2 et seq. of Wallack). It would have been obvious to an artisan at the time of the invention to combine adjusting the size of user input as taught by Wallack into the user input area as taught by Inaki and modified by Glaser.

Said artisan would have been motivated to combine Wallack into Inaki in order to auto size the field according to textual data received in the fields in a computer-generated form (i.e. col. 2 line 23 et seq. of Wallack).
(Ans. 5).

Regarding the claimed indication of a specified number of characters in a data field, we observe that in the rejection of claim 1 the Examiner also points to Inaki at col. 10, l. 31, which describes Fig. 11C as showing an input area with a capacity of 44 characters. We observe that adjacent Fig. 11D depicts a field for “COMPANY NAME” with the remaining available character slots designated by a lower case “x.” (Ans. 3).

The Supreme Court guides that the conclusion of obviousness can be based on the interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, and an obviousness “analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

Here, on this record, we agree with the Examiner that the combined teachings and suggestions of the Inaki, Glaser, and Wallack references would have at least *suggested* the disputed visual indication to the user that the user input area (entry field) will accommodate visual representations of a remaining number of the specified number of characters of the data field (i.e., allocated memory) that corresponds to the displayed user input area. *See Bell*, 991 F.2d at 783. Moreover, we are of the view that Appellants’ representative claim 1 encompasses a predictable use of prior art elements according to their established functions. To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

For essentially the same reasons set forth by the Examiner, and for the reasons discussed above, we are not persuaded by Appellants’ arguments that the Examiner erred in reaching the legal conclusion of obviousness. Accordingly, based on *Issues (1) and (2)*, we sustain the Examiner’s obviousness rejection of representative claim 1. Claims 2-20 (not argued separately) fall therewith. *See* 37 C.F.R. § 41.37(c)(vii).

DECISION

We affirm the Examiner's decision rejecting claims 1-20 under § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2011).

ORDER

AFFIRMED

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